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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,928	01/11/2002	Ernst Rudolf F. Gesing	Mo-6884/LeA 33871	3956

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EXAMINER

MORRIS, PATRICIA L

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 06/11/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,928

Applicant(s)

Gesing et al

Examiner

P. Morris

Group Art Unit

1625

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

P r i d f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 3/24/03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 2-4, 8 and 10-28 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 2-4, 8 and 10-28 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 8 + 11
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

Claims 2-5, 8 and 10-28 are under consideration in this application.

Election/Restriction

The lack of unity requirement is deemed sound and proper and is hereby made FINAL.

Again, this application has been examined with regard to the elected compounds wherein R¹, R³ and R⁴ represent non-heterocyclic groups and Q¹, Q² and R² as set forth in claim 1, exclusively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35 U.S.C. 102(e) and 374 was amended by H.R. 2215 (Technical Amendment Act) was enacted on 11/2/02 and the effective date is 11/29/00. Hence, Muller et al. I is an effective reference under 35 U.S.C. 103.

Claims 1-4, 8 and 10 are rejected under 35 U.S.C. 103(a) as being obvious over the combined teachings of Muller et al. I, II and Daum et al. for the reasons set forth in Paper no. 7.

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Again, Muller et al I, II and Daum et al. teach analogous compounds having the same use. The prior art compounds differ from the compound claimed herein as position isomers. Example 1 of Muller et al. I, II have the same substituents except that the ester and methyl groups are interchanged. Further, Daum et al. teach that the ester group on the thiophene ring may be at different positions on the ring. Note, for example, column 6, lines 1-17, therein. One having ordinary skill in the art would have been motivated by the disclosure of the prior art compounds to arrive at other compounds within the claimed genus. The motivation to make these compounds is their close structural similarities to the disclosed compounds. Note that the disclosed compounds have herbicidal activity, thus the skilled artisan would expect such structurally similar compounds to possess similar properties.

Applicants appear to argue that one having ordinary skill in the art would not have been motivated to produce the compounds encompassed by the claims. The motivation is not abstract but is always related to the properties or uses that one having ordinary skill in the art would have expected the resulting compound to exhibit. In situations involving chemical compounds bearing a close structural similarity, the requisite motivation stems from the expectation that compounds exhibiting closely similar structures will exhibit similar properties. Applicants argue that the ester group is always on the 2-position of the thiophene ring of Muller et al. I, II. However, Daum et al. teach that the ester group on thiophene ring may be at different positions and herbicidal activity is retained. No unexpected or unobvious properties are noted.

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A compound need not be a homolog or isomer of a prior art compound in order to be susceptible to a rejection based on structural obviousness. The name used to designate the structural relationship between compounds is not controlling, it is the closeness of that relationship. Note: In re Payne et al., 203 USPQ 245. When chemical compounds have a “very close” structural similarity and similar utilities, a prima facie case of obviousness may be made, note In re Grabiak, 226 USPQ 870, “without more”. Thus, a difluorinated compound was held unpatentable over the prior art dichloro compound on the basis of similar reasoning to the above; Ex parte Wiseman (POBA 1953) 98 USPQ 277.

Obviousness can be based on the concept of “isoterism”, the substitution, in the parent compound, of one atom or group of atoms for another atom or group of atoms having similar properties, such as electronic or steric configuration; Ex parte Engelhardt, (POBA 1980) 208 USPQ 243.

Applicants do not point to any objective evidence which demonstrates that the claimed compounds as a class exhibit any properties which are actually different from the closest prior compounds embraced by Muller et al. I, II In re Wilder, 563 F.2d 457, 195 USPQ 426 (CCPA 1977); In re Hoch, 428 F.2d 1341, 166 USPQ 406 (CCPA 1970).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Muller et al. I, II and Daum et al. for the reasons set forth in Paper no. 7.

Again, Muller et al. I, II and Daum et al. disclose the instant process. Note, for example, process variant (a) in Column 3, lines 1-32 of Muller et al. I or process variant (b) of Daum et al.

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As here, a sulphonamide is reacted with a triazolinone. The reaction of a specific sulphonamide with a triazolinone does not render the process step itself patentable, anew; In re Albertson, 141 USPQ 730, which was specifically reaffirmed on the last page of In re Kuehl, 177 USPQ 250.

Contra to applicants' arguments in the instant response, one having ordinary skill in the art would have been motivated to employ the process of the prior art with the expectation of obtaining the desired product, because he would have expected the analogous starting materials to react similarly. It has been held that application of an old process to a new and analogous material to obtain a result consistent with the teachings of the art would have been obvious to one having ordinary skill. The reactive sites are the same.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 8 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,180,567 in view of Daum et al. for the reasons set forth in Paper no. 7.

As set forth in Paper no. 7, the instant compounds are the position isomers of '567. Further, Daum et al. teach that the substituents on the thiophene ring may be at different positions and still retain herbicidal activity. Hence, patentable distinction is not seen.

Claims 1-3, 8 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,094,685. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant compounds wherein R² is hydrogen are the position isomers of the claimed compounds therein. The instant and prior art compounds both are useful as herbicides.

Conclusion

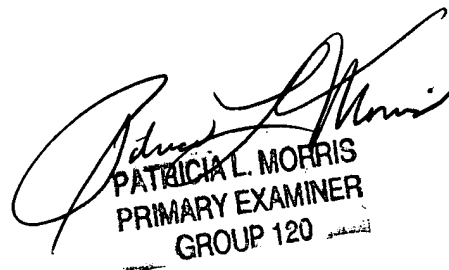
No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Morris whose telephone number is (703) 308-4533. The examiner can normally be reached Mondays through Fridays.



PATRICIA L. MORRIS
PRIMARY EXAMINER
GROUP 120

plm

June 10, 2003